

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 09/702,737

PATENT APPLICATION

REMARKS

Claims 21-41 are all the claims pending in the application. All of these claims stand rejected for obviousness-type double patenting over claims 1-24 of USP 5,854,893 in view of Marshak, "BeyondMail for Windows". These claims also stand rejected for obviousness-type double patenting over claims 1-44 of USP 6,237,025 in view of Marshak. In response to these rejections, Applicants submit Terminal Disclaimers, thereby obviating these rejections.

The Examiner also has rejected claims 21-41 under 35 U.S.C. § 103(a) as unpatentable over USP 5,195,086 (Baumgartner) in view of Marshak and Rangan, "Software Architecture for Integration of Video Services in the Etherphone System". Applicants respectfully traverse this rejection, and submit that the rejection is overcome further by the foregoing amendments to the claims. Applicants respectfully request reconsideration and allowance of the claims in view of the following arguments.

The foregoing claim amendments which refer to first and second directories of video-enabled participants focus the invention on the establishment of an initial teleconference by defining two directories of video-enabled participants. Additional participants may or may not be video-enabled, but the directory feature of the invention focuses on video-enabled participants. Moreover, the claims define two directories, one of which is a subset of the other.

The additional amendments to the claims are clarifying in nature, improving antecedent basis where appropriate, and do not change the scope of the claims in any way. Moreover, those amendments are not made in response to any rejection.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 09/702,737

PATENT APPLICATION

The Examiner has not cited a reference which teaches or suggests directories of video-enabled participants. Rather, the Examiner has cited Marshak for the teaching of directories, specifically, public and private directories. The claimed directory feature in claims 21-41 of the present application is distinguishable from Marshak in at least the following respects:

- 1) Marshak's e-mail directory *per se* does not teach or suggest applicability in a videoconferencing context.

The real-time video collaboration world is different from the deferred-in-time text-exchange collaboration of the e-mail world, particularly in regards to immediacy. See, for example, p. 59, l. 6 to p. 69, l. 4 of the present application, describing a scenario involving an expert who is required to be in contact with certain individuals quickly and on a real-time basis. In this example, and elsewhere in the present application discussing video collaboration, the need for immediacy uniformly abounds.

As described in the present application, in order to avail oneself of the various video collaboration features which are available in accordance with the present invention, a video-enabled user will want to communicate with other video-enabled users in real time on the network, and hence will want access to a easily used larger directory of such users; however, it should be noted that email by design is not real-time communication serving the need for immediacy, unlike a video-enabled conference in which immediacy is apparent. However, typically there are a relatively small number of users in the complete directory with whom the video-enabled user will want to communicate frequently and rapidly. As a result, it would be very practical and useful to have a short directory of a such a selected group of video-enabled

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 09/702,737

PATENT APPLICATION

participants, the thus selected group thus forming a subset of the larger directory. In recognition, the application addresses this notion through the concepts of "quick dial" and "hot keys."

In the present application, such a "quick dial" feature is described, in which entries from a larger directory (rolodex) are dragged into a "quick dial" directory of potential participants with whom frequent and rapid real-time communication is common. Since the quick dial directory is populated by "dragging" in entries from the public directory, the quick-dial directory is by design and structure a subset of the public directory. *See, e.g.*, page 31, lines 6-14 of the present application. Thus, as claimed in claims 21-41, the second directory is a subset of the first directory. In contrast, Marshak fails to teach or suggest in any a process for creating a subset relation, and likewise fails to provide any motivation for the claimed subset relation.

The video-enabled user may indeed also need to access to other teleconferencing participants who are not video-enabled, and these may be (but need not necessarily be) included in the claimed first and second directories, but the video-enabled aspect of the participants called out in the first and second directories nevertheless speaks to the desirability of having the second directory be a subset of the first directory. Teleconferencing participants who are not video-enabled also may be accessible through "additional communication types" (claims 23, 24, 33, and 34).

Marshak's reference to private and public e-mail directories would not have suggested to the ordinarily skilled artisan, at the time the present application was made, the desirability of having two directories of video-enabled participants where one directory is a subset of the other.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 09/702,737

PATENT APPLICATION

Overall, no subset relation is taught in Marshak, no process for creating a subset relation is taught therein, and no motivation for the claimed subset relation is taught or anticipated therein.

Rangan obviously lacks any kind of directory feature (names or users must be input manually). Therefore, Rangan supplies none of the deficiencies of Marshak. Moreover, contrary to the Examiner's assertion, Baumgardner's sparse reference to video in no way enables, much less suggests, addition of Marshak's e-mail public and private directories, and certainly not a modification of Marshak to facilitate participation in videoconferencing. The sparse reference to video in Baumgardner, coupled with the lack of suggestion of the use of any kind of video directory in Rangan, means that this combination of prior art in no way would have suggested to the ordinarily skilled artisan the desirability of providing two directories of video-enabled users in a videoconferencing context.

2) Marshak talks about a public e-mail directory and a private e-mail directory, but does not in any way refer to one directory as a subset of the other. In contrast, in the invention as originally claimed, the second directory is expressly a subset of the first directory.

In the context of videoconferencing, this aspect of the invention makes more sense than in an e-mail context, for the following reason. An e-mail user may be on a network, and as such, may have access to a directory of e-mail users – this directory would correspond to Marshak's public directory. However, in order to communicate with users outside the network, special or different e-mail addresses, not in the network directory, may be necessary. The e-mail user

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 09/702,737

PATENT APPLICATION

desiring to communicate with users outside the network thus will have, in a private directory, e-mail addresses not found on the network.

As a result, the private directory will not be a subset of the public (network) directory. Not only is there no reason for the private directory to be a subset of the public directory; if the private directory were a subset of the public directory, the private directory owner would not be able to communicate outside the network. In an e-mail world, a user does want to communicate outside the network, and so would want a private directory that is not a subset of a public directory.

Therefore, Marshak's teaching of a public directory and a private directory would not have suggested, to the ordinarily skilled artisan, the desirability of having the private directory be a subset of the public directory. Even assuming *arguendo* the desirability of having a "more efficient grouping and identification of the participants" (Office Action, p. 5, lines 1-2), there is no indication that at the time the present invention was made, that the subset relationship between the first and second directories would have been obvious to the ordinarily skilled artisan, given Marshak's teachings. As discussed above, Marshak certainly does not provide the necessary teaching or suggestion, and Rangan and Baumgardner are silent regarding any desirability of video-enabled directories in the videoconferencing context.

Pursuant to the foregoing discussion, Applicants submit that claims 21-41 are patentable.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 09/702,737

PATENT APPLICATION

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



Frank L. Bernstein
Registration No. 31,484

SUGHRUE MION, PLLC
1010 El Camino Real, Suite 360
Menlo Park, CA 94025

Tel: (650) 325-5800
Fax: (650) 325-6606

Date: June 10, 2002

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT UNDER 37 C.F.R. § 1.111 is being facsimile transmitted to the U.S. Patent and Trademark Office this 10th day of June, 2002.


Thea K. Wagner

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 09/702,737

PATENT APPLICATION

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows.

21. (Amended) A teleconferencing system
for conducting a teleconference
among a plurality of participants comprising:
- (a) a plurality of video display devices each having associated
 - (i) participant video capture capabilities, and
 - (ii) participant audio
 - (1) capture and
 - (2) reproduction capabilities; and
 - (b) at least one communication path
 - (i) along which signals
 - (1) representing participant audio and video
 - (ii) can be transmitted,
- wherein the system is configured to
- (a) display
 - (i) a first and a second directory [of] each including potential video-enabled participants in which
 - (1) the first directory is viewable by all potential video-enabled participants, and
 - (2) the second directory is a subset of the first directory and viewable by a single participant,
 - (ii) on at least one video display device; and
 - (b) to initiate collaboration

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 09/702,737

PATENT APPLICATION

- (i) upon a selecting participant [selecting] establishing communication
 - (1) with [each] a selected participant
 - (2) to define [a] the teleconference.
- 23. (Amended) The teleconferencing system of claim 21, wherein
 - (a) a selecting participant can
 - (i) select
 - (1) at least one of the participants and
 - (2) at least one of a displayed set of additional communication types; andwherein the system is further configured to
 - (i) establish communication
 - (1) of the selected type
 - (2) with [each] a selected participant.
- 24. (Amended) The teleconferencing system of claim 23, wherein
 - (a) the set of additional communication types includes at least one of:
 - (i) data conferencing, videoconferencing, telephone conferencing, sending faxes, sending electronic mail, and the sending of multimedia mail messages.
- 25. (Amended) The teleconferencing system of claim 23, wherein
 - (a) the selecting participant can use
 - (i) at least one computer graphic user interface
 - (ii) to select
 - (1) at least one of the participant(s) and/or
 - (2) at least one of the [collaboration] communication types.
- 26. (Amended) The teleconferencing system of claim 23, wherein the system
 - (a) defaults
 - (i) to a default [collaboration] communication type
 - (ii) upon selection of a participant.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 09/702,737

PATENT APPLICATION

27. (Amended) The teleconferencing system of claim 21, wherein the system is further configured to allow a participant:

- (a) to select
 - (i) a further participant
 - (ii) from the potential teleconference participants and
- (b) add
 - (i) the new participant
 - (ii) to [an existing] the teleconference[call].

30. (Amended) A method for conducting a teleconference among a plurality of participants, each having an associated video capture and display and audio capture and reproduction capabilities, the method comprising the steps of:

- (a) displaying
 - (i) a first and a second directory [of] each including potential video-enabled participants in which
 - (1) the first directory is viewable by all potential video-enabled participants,
 - and
 - (2) the second directory is a subset of the first directory and viewable by a single participant
- (b) selecting
 - (i) one or more participants
 - (1) from among a plurality of the displayed potential participants; and
- (c) establishing communication
 - (i) with [each] a selected participant
 - (ii) to define the teleconference.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 09/702,737

PATENT APPLICATION

32. (Amended) The method of claim 30, further comprising the steps of:
- (a) selecting
 - (i) one or more desired participants
 - (ii) from the first [participants] directory; and
 - (b) selecting
 - (i) one or more desired participants;
 - (ii) from the second [participant] directory; and
 - (c) establishing communication
 - (i) with all selected participants.
33. (Amended) The method of claim 30, further comprising the steps of:
- (a) selecting a communication type,
 - (i) from a displayed set of additional communication types; and
 - (b) establishing communication
 - (i) of the selected type,
 - (ii) with each selected participant(s).
34. (Amended) The method of claim 33, wherein
- (a) the set of additional communication types includes at least one:
 - (i) data conferencing, videoconferencing, telephone conferencing, sending faxes, sending electronic mail and sending multimedia mail messages.
35. (Amended) The method of claim 33, wherein
- (a) the step of selecting
 - (i) one or more participants
 - (ii) invokes a default [collaboration] communication type.
36. (Amended) The method of claim 30, further comprising the steps of:
- (a) selecting
 - (i) a new participant

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 09/702,737

PATENT APPLICATION

- (ii) from among a plurality of potential teleconference participants;
and
- (b) adding
 - (i) the new participant
 - (ii) to [an existing] the teleconference.